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Timothy H. Van Dyke, Patent Attorney
Reg. No. 43,218

PETITION TO WITHDRAW HOLDING
OF ABANDONMENT, (AND IN THE
ALTERNATIVE) PETITION TO
REVIVE FOR UNINTENTIONAL
ABANDONMENT UNDER 37 CFR
§1.137(b)
Examining Group 1600
Patent Application
Serial No. 08/554,454

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Examiner : Lubet, Martha T.
Art Unit : 1600
Applicants : Van Der Ploeg; Warmke
Serial No. : 08/554,454
Filed : November 6, 1995
For : PROCESS FOR IDENTIFYING PARACATION CHANNEL
MODULATOR
Docket No : 19338CDCPA2 (Original Attorney Docket No. is 19338DA)

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PETITIONS OFFICE

Assistant Commissioner for Patents
Washington, D.C. 20231

PETITION TO WITHDRAW HOLDING OF ABANDONMENT UNDER 37 CFR 1.181(a),
with SUBMISSION OF ACCOMPANYING TERMINAL DISCLAIMER, and, in the
alternative, PETITION TO REVIVE AN APPLICATION FOR PATENT
UNINTENTIONALLY ABANDONED UNDER 37 CFR §1.137(b)

The United States Patent and Trademark Office provided a Notice of Abandonment regarding the above referenced case, dated 02/27/2001. Due to irregularities in the USPTO correspondence, particularly using an old, incorrect address, and an inconsistency in the Attorney docket number, it is respectfully urged that the holding of abandonment be reconsidered and withdrawn. A detailed explanation of events is provided below, which includes an explanation for the delay in submitting this petition under 37 CFR 1.181(a).

In the event that the Commissioner does not grant the petition to withdraw the holding of abandonment, the Applicant herewith further petitions for revival of the application under 37 CFR 1.137(b). It is the Applicant's express desire that the Commissioner give due consideration to the grounds and equity involved in the decision to withdraw the holding of abandonment, despite the second petition for revival, herein presented in the alternative.

01/22/2002 AKELLEY 00000014 08554424

01 FC:141	1280.00 OP
02 FC:131	740.00 OP
03 FC:105	130.00 OP

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Fees as required are indicated in the appropriate sections below, and payment authorizations as required are enclosed. A Terminal Disclaimer is provided for use only with Part 1, in the event the Petition for Withdrawal of a Holding of Abandonment is granted. This disclaimer, provided in Appendix A, should be marked "void" or destroyed in the event that the Petition for Withdrawal of a Holding of Abandonment is not granted.

Part 1: Petition for Withdrawal of Holding of Abandonment

I. Issue: Where Applicant's attorney has filed a series of continuation applications for an invention (where the series has retained the same Application number), and where the Patent Office has mailed a Notice to File Missing Parts to an old address never used for the latest continuation, which further specifies an incorrect attorney docket number, so that the attorney believes the Notice pertains to an abandoned file, the Patent Office should withdraw a subsequent abandonment based upon failure to comply with such Notice.

II. Applicable Rules: A withdrawal of examiner's holding of abandonment is allowed as set forth in MPEP 711.03(c)(I.). A Petition may be based on the Applicant's contention that 1) there is a disagreement as to the sufficiency of the reply, or 2) there is a disagreement as to controlling dates. Under 37 CFR 1.181(f), a Petition not filed within two months from the action complained of may be dismissed as untimely. However, the Patent Office, in its discretion, may consider such untimely Petition on its merits if a terminal disclaimer is provided (for an application filed after June 8, 1995, see MPEP 711.03(c), page 700-139).

III. Summary of Facts & Timeline:

#	Action/Mailing	Atty. Docket #	Date
1	Application serial no: 08/338,702 filed	19338	11/10/1994
2	Divisional application based on '702 is filed, as application serial no: 08/554,424	19338DA	11/6/1995
3	US Patent 5,550,049 issued from original application '702	19338	08/27/1996
4	Three-way restriction requirement	N/A	01/23/1997
5	CPA filed on '424 application	19338CA	04/28/1998
6	CPA filed on '424 application	19338CD	03/24/1999
7	CPA filed on last CPA of '424; <u>this was filed from new office address, which was clearly indicated as the correspondence address (see Appendix B)</u>	19338CDCPA	10/04/1999
8	Subsequent CPA filed on '424 application; <u>this also was filed from the new office address, and properly indicated such address as the correspondence address (see Appendix C)</u>	19338CDCPA2	04/13/2000
9	USPTO mails Notice to File Missing Parts to old address (426 Anderson Ave.). Docket is shown as 19338DA. This is	19338DA is shown.	04/25/2000

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	never forwarded to new address.		
10	USPTO re-mails Notice to File Missing Parts, now to correct address, with copy of earlier mailed Notice. Old file docket, 19338DA, is still indicated.	19338DA is shown.	07/26/2000
11	USPTO mails Notice of Abandonment.	19338DA is shown.	02/27/01
12	Review of documents during transfer of case to new attorney reveals that current CPA, rather than an earlier CPA, was abandoned.	N/A	September, 2001

IV. Discussion and Analysis

The most recent of the CPAs for U.S. Patent application number 08/554,424 was filed on April 13, 2000 from the new firm address at 1630 Hillcrest Street, Orlando, Florida, 32803. This address was clearly indicated as the appropriate correspondence address for this application. Under 37 CFR 1.33(a)(2), and as indicated in MPEP 601.03 (August 2001 edition, pages 600-19 to -20), the attorney of record is one of the parties authorized to change the correspondence address. Here, the attorney of record, Mr. Gerard H. Bencen, indicated the new, 1630 Hillcrest Street address, both on the first page of the Petition accompanying the CPA, and on the last page of the CPA application itself, beneath the date and signature (See Appendix B).

Nonetheless, the USPTO originally sent the Notice to File Missing Parts to the former firm address at 426 Anderson Court, Orlando, Florida, 32801 (# 9). This law office never received the Notice from this first mailing. When the Notice was later re-mailed to the correct address (# 10), a copy of the original Notice was enclosed to provide the substantive message. That this original Notice indicated the old address, which was not used in the CPA filed April 13, 2000, contributed significantly to the belief that this Notice pertained to a previous application, the abandonment of which was expected in light of the April 13, 2000 CPA. Accordingly, no action was considered necessary with regard to this Notice.

In September 2001, the Notice of Abandonment was recognized to apply to the most recently filed CPA in the series. This was noticed during a detailed review of all files in the case, undertaken in order to transfer the case to an associate attorney as Mr. Bencen was leaving the firm. Shortly thereafter, the client was informed of the status, and shortly thereafter, the client indicated that this firm should take appropriate steps bring the application back to a pending status.

Although not dispositive in and of itself, the indication on the USPTO papers that the Attorney Docket No. was "19338DA" also contributed to the erroneous conclusion on the part of the attorney handling the case, Mr. Gerard Bencen, that the papers referred to an earlier CPA and not the most recent one.

Thus, based primarily on the use of the incorrect, earlier address on the Notice to File Missing Parts, and on the later-received Notice of Abandonment, where that address was never used in

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the April 13, 2000 application and where that application adequately provided the new correspondence address under the rules, the resultant inaction based on the conclusion that the papers regarded an earlier application, is not a proper ground for abandonment. Rather, this Petition for the withdrawal of the holding of abandonment should be granted, given the role the USPTO played in inadvertently providing the mis-leading information that lead to this conclusion.

As noted above, a Terminal Disclaimer is provided for the entry into this case for entry in this application only if this first Petition is granted.

V. Conclusion of Part 1

Based on the foregoing, it is respectfully petitioned that the holding of abandonment for U.S. Patent Application No. 08/554,454, filed 11/06/1995, be withdrawn. For processing of Part 1, the following are provided:

- ☒ Appendix A - Terminal Disclaimer, Form PTO/SB/63, for use only if this Petition is granted
- ☒ Appendix B - Copy of Continued Prosecution Application (CPA) Request Transmittal, filed 04/13/00.
- ☒ Form PTO-2038, for \$130.00 Petition Fee and for \$110.00 Statutory Disclaimer fee, for use only if this Petition is granted.

If this Petition is not granted, it is requested that the Commissioner consider and grant the Petition in Part 2, immediately below.

Part 2: Petition to Revive an Unintentionally Abandoned Application Pursuant to 37 C.F.R. 1.137(b).

APPLICANT HEREBY PETITIONS FOR REVIVAL UNDER 37 C.F.R. 1.137(b) OF U.S. PATENT APPLICATION SERIAL NUMBER 08/554,454. The following items, as checked, are provided, which Petitioner asserts satisfy the requirements for an acceptable petition pursuant to 37 C.F.R. 1.137(b):

1. Petition Fee

- ☒ For other than small entity - fee \$ 1,280.00 (37 C.F.R. 1.17(m)).

2. Reply and/or fee

- ☒ A. The reply and/or fee to the above-noted Notice to File Missing Parts in the form of Payment of the Application Filing Fee, \$740.00 (37 C.F.R. 1.16(a)).
- ☒ B. The surcharge under 37 C.F.R. 1.16(e) of \$130.00.

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3. Terminal Disclaimer with disclaimer fee

☒ Since this utility/plant application was filed on or after June 8, 1995, no terminal disclaimer is required.

4. Statement of Unintentional Abandonment:

The Applicant states that the entire period of delay in providing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. 1.137(b) was unintentional. The Applicant has provided a table and discussion above in Part 1 that chronicles the delay.

Enclosure for Part 2: Petition to Revive an Unintentionally Abandoned Application Pursuant to 37 C.F.R. 1.137(b).

☒ Form PTO-2038, for Petition fee of \$1,280.00 (37 C.F.R. 1.17(m)), for Application filing fee of \$740.00 (37 C.F.R. 1.16(a)) and for Surcharge of \$130.00 (37 C.F.R. 1.16(e)), for use only if this petition is granted.

The Examiner is invited to call the undersigned if clarification is needed on any aspect of this Petition To Revive, or if the Examiner believes a telephonic interview would expedite the prosecution of the subject application.

Respectfully submitted,



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Attorney for Applicant
Van Dyke & Associates, P.A.
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Orlando, FL 32803
Ph: 407-228-0328
Fax: 407-228-0329

11-1-2001
Date

Our Docket No: 19338CDCPA2

Serial No: 08/554,454

APPENDIX A

1. Terminal Disclaimer

PTO/SB/93 (10-00)

Approved for use through 10/31/2002, OMB 0861-0031

U.S. Patent and Trademark Office; U. S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TERMINAL DISCLAIMER TO ACCOMPANY PETITIONDocket Number (Optional)
19338CDPA2

In re Application of:

Name: Van Der Ploeg & Warmke

Application Number: 08/554,454

Filed: 11/6/1995

For: PROCESS FOR IDENTIFYING PARACATION CHANNEL MODULATOR

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PETITIONS OFFICE

The owner, Merck & Co., Inc. of 100 percent interest in the above-identified application hereby disclaims a terminal part of the term of any patent granted the above-identified application equivalent to: (1) if the above-identified application is a design application, the period of abandonment of the above-identified application, and (2) if the above-identified application is a utility or plant application, the lesser of: (a) the period of abandonment of the application; or (b) the period extending beyond twenty years from the date on which the above-identified application was filed in the United States or, if the application contains a specific reference to an earlier filed application(s) under 35 U.S.C. 120, 121, or 365(c), from the date on which the earliest such application was filed. This disclaimer also applies to any patent granted on a utility or plant application filed before June 8, 1995, or a design application, that contains a specific reference under 35 U.S.C. 120, 121, or 365(c) to the above-identified application. This disclaimer is binding upon the grantee, and its successors or assigns.

Check either box 1 or 2 below, if appropriate.

1. ☐ For submissions on behalf of an organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the organization.
2. ☒ The undersigned is an attorney or agent of record.


Signature11-1-2001
DateTimothy H. Van Dyke
Typed or printed name

- ☒ Terminal disclaimer fee under 37 CFR 1.20(d) included.

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

* Statement under 37 CFR 3.73(b) is required if terminal disclaimer is signed by the assignee (owner).
Form PTO/SB/96 may be used for making this certification. See MPEP § 324.

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

Our Docket No: 19338CDCPA2

Serial No: 08/554,454

APPENDIX B

1. Copy of Continued Prosecution Application (CPA) Request Transmittal (2 pages).

CONTINUED PROSECUTION APPLICATION (CPA)**Request Transmittal**

(Only for Continuation or Divisional Applications Under 37 CFR § 1.53(d))

Attorney Docket No.

19338CDCPA2**TO THE ASSISTANT COMMISSIONER FOR PATENTS:**

This is a request for a ☒ continuation ☐ divisional application under 37 CFR § 1.53(d) (Continued Prosecution Application (CPA)), of prior application No. 08/554,424 filed on November 6, 1995, and entitled

FAX RECEIVED**PROCESS FOR IDENTIFYING PARACATION CHANNEL MODULATORS.****NOV 01 2001**

Name of Applicant(s): Warmke, Jeffrey, W; Van Der Ploeg, Leonardus

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- (X) The issue fee in the prior application has not been paid.
 (X) The prior application is abandoned under 37 CFR § 1.53(d)(2) as of the filing date of this continued prosecution application.
 (X) Please use the file jacket and all the contents of the prior application, including the specification, drawings, and entered amendments, to constitute the new application.

Foreign Priority - 35 USC § 119

- () Foreign priority under 35 U.S.C. § 119 has been claimed in prior application No. _____ / _____ filed on _____, in (country) _____.
 () The certified copy has been filed in prior application No. _____ / _____ filed on _____.
 () A separate paper claiming direct priority to a foreign application is enclosed herewith. A certified copy of the foreign application will be provided in due course.

Other Amendments

- () Before calculating the filing fee, amend the prior application as follows:
 () Cancel the following claims: _____
 () Enter the enclosed preliminary amendment.
 () Enter the unentered amendment(s) previously filed on _____ under 37 CFR § 1.116 in the prior nonprovisional application. A copy of the amendment(s) is (are) enclosed.

Inventorship Statement

- () Delete the following named inventors in the prior application as inventors in this application in accordance with 37 CFR § 1.53(d)(4) as a result of a change in the claimed subject matter: _____

Assignment

- (X) The prior application is assigned to Merck & Co., Inc.

Enclosures

- () Specification; Total Pages. () Drawing(s); Total Sheets.

Oath or Declaration:

- () A newly executed combined oath or declaration and power of attorney (37 CFR § 1.63(d)(4)).
 () A copy from a prior application for continuation/divisional (37 CFR § 1.63(d)(1)).
 () Incorporation by reference. The entire disclosure of the prior application, from which a copy of the oath or declaration is supplied, is considered as being part of the disclosure of the accompanying application and is hereby incorporated by reference therein.
 () Power of Attorney was changed during prosecution of prior application to _____.
 () Correspondence address was changed during prosecution of prior application to that shown below.
 () Priority Documents (if foreign priority is claimed).
 () Associate Power of Attorney.
 () Verified statement(s) to establish status as a small entity:
 () Is enclosed. () Small entity status is no longer claimed.
 () A statement was filed in the prior application, and small entity status is still proper and desired.
 (X) Return Receipt Postcard. () Preliminary Amendment(s). () Unentered Amendment(s).
 () A check in the amount of \$ _____ for the Filing Fee.
 (X) Other: Petition and Fee for a two month extension of time

Filing Fee Calculation

CLAIMS AS FILED				
FOR	NO. FILED	NO. EXTRA	RATE	FEE
Total Claims	7	0	\$18.00	\$ 0.00
Independent Claims	1	0	\$78.00	\$ 0.00
Multiple Dependent Claim Fee (if applicable)				\$ 0.00
Assignment Recording Fee (if applicable)				\$ 0.00
Basic Filing Fee				\$ 760.00
Total Filing Fee				\$ 760.00

Please charge \$ _____ to Deposit Account No. _____ pursuant to 37 CFR § 1.25. At any time during the pendency of this application, the Commissioner is hereby authorized to charge any fees required or credit any overpayment to this Deposit Account. A duplicate copy of this sheet is enclosed for fee processing against this Deposit Account.

Respectfully submitted,

By: 

Gerard H. Bencen
Attorney of Record
Reg. No. 35746

Date: 04/13/00

Correspondence Address:

Bencen & Van Dyke, P.A.
1630 Hillcrest Street
Orlando, Florida 32803
Phone: 407-228-0328
Fax: 407-228-0329

I hereby certify that this is being deposited with the U.S. Postal Service "Express Mail Post Office to Addressee" service under 37 CFR § 1.10 on the date indicated below and is addressed to:

Assistant Commissioner for Patents
Box CPA
Washington, D.C. 20231

By: 

Typed Name: Gerard H. Bencen

Express Mail Label No.: EK670287593US

Date of Deposit: 04/13/00